



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,990	04/30/2001	John L. Levenda	38190/209224	2934

826            7590            07/18/2003

ALSTON & BIRD LLP  
BANK OF AMERICA PLAZA  
101 SOUTH TRYON STREET, SUITE 4000  
CHARLOTTE, NC 28280-4000

[REDACTED] EXAMINER

BOYD, JENNIFER A

ART UNIT	PAPER NUMBER
1771	7

DATE MAILED: 07/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/845,990	LEVENDA, JOHN L.
	Examiner Jennifer A Boyd	Art Unit 1771

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 06 May 2003.

2a) This action is FINAL.                  2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-12 and 18-24 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-12 and 18-24 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____ .

**DETAILED ACTION*****Response to Amendment***

1. The Applicant's Amendments and Accompanying Remarks, filed May 6, 2003, have been entered as Paper No. 6 and have been carefully considered. Claims 13 – 16 have been withdrawn from consideration and cancelled due to the restriction requirement. The Specification has been amended. Claims 1-12 and 17 - 24 are pending. In view of the Applicant's amendment, the Examiner withdraws the objection of claim 10 as set forth in paragraph 4 of Paper No. 5. The Examiner withdraws the 35 U.S.C. 112, 2<sup>nd</sup> paragraph rejection of claims 1 – 12 and 23 as set forth in paragraph 8 of Paper No. 5. The Examiner withdraws the 35 U.S.C. 102(b) rejection of claims 1, 5 and 12 as being anticipated by Hoey (US 3,891,487), the 35 U.S.C. 103(a) rejections of claims 2 – 4 and 6 - 9 as being unpatentable over Hoey (US 3,891,487) in view of Gleim (US 5,976,671), of claims 10 and 11 as being unpatentable over Hoey (US 3,891,487) in view of Piacente et al. (US 5,858,160), of claim 23 as being unpatentable over Gleim (US 5,976,671) in view of Piacente et al. (US 5,858,160), and of claims 19 and 21 as being unpatentable over Gleim (US 5,976,671) in view of Hoey (US 3,891,487) as set forth in Paper No. 5. Despite these advances, the invention as currently claimed is not found to be patentable for reasons herein below.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 1771

3. Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way to reasonably convey to one skilled in the relevant art that the inventor(s), as the time the application was filed, has possession of the claimed invention. The phrase “non-foam” is new matter, because this negative limitation is not literally supported by the specification. *Ex Parte Grasselli*, 231 USPQ 393. Contrary to the applicant’s statement in the present response, this limitation is not supported by the specification. There is no mention of “non-foam” in the specification. It is mentioned that the embossable layer is a pigmented resin comprising preferably polyurethane, and alternatively a polyester, a phenolic or a combination of the three and has a thickness between about 2 to 8 mils. However, this does not exclude all foams which can be made of such resins and applied in that thickness range.

***Claim Rejections - 35 USC § 102***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 17 – 18, 20, 22 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Gleim (US 5,976,671). The rejection is maintained.

As to claims 17, 20 and 24, Gleim teaches a decorative laminate (See Figure 3). The printed laminate (40) comprises a textured layer (32), a structural layer (34), adhesive containing layer (36), printed layer (42) and capping layer (44). The textured layer, or “embossable layer”, is comprised of a melt processable thermoplastic material which can adopt texture imparted by a texture media (column 5, lines 12 – 16). The textured layer can be colored and include

Art Unit: 1771

pigmented particles (column 5, lines 42 – 45). The printed layer, or “ink layer”, can include ink or toner. The ink or toner in the printed layer is deposited on the textured layer by a screen, electrostatic transfer, ink jet and gravure processes (column 6, lines 15 – 20), therefore, the textured layer will have at least one same color as found in the “ink layer”. The capping layer, or “partially transparent layer”, is comprised of a thermoplastic fluorinated polymer film such as PVF (polyvinyl fluoride) or PVDF (polyvinylidene fluoride) (column 6, lines 10 – 27). The capping layer can be made of a clear PVDF film such as Avimark C40 and C70 (column 6, lines 23 – 27).

As to claim 18, Gleim teaches that due to the transfer of ink or toner from the “ink layer” to the “embossable layer”, the predominant color of the “ink layer” will be the predominant color of the “embossable layer”.

As to claim 22, Gleim teaches that the textured layer, or “embossable layer”, can include polyurethane (column 5, lines 29 – 30).

#### ***Claim Rejections - 35 USC § 103***

6. Claims 1 – 12, 19, 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gleim (US 5,976,671) in view of Hirosaki (JP 05-254050).

Gleim is directed to a decorative laminate used for commercial aircraft interiors (column 1, lines 10 – 11).

As to claims 1 and 2, Gleim teaches a decorative laminate (See Figure 3). The printed laminate (40) comprises a textured layer (32), a structural layer (34), adhesive containing layer (36), printed layer (42) and capping layer (44). The textured layer, or “embossable layer”, is

comprised of a melt processable thermoplastic material which can adopt texture imparted by a texture media (column 5, lines 12 – 16). The textured layer can be colored and include pigmented particles (column 5, lines 42 – 45). The printed layer, or “ink layer”, can include ink or toner. The capping layer, or “partially transparent layer”, is comprised of a thermoplastic fluorinated polymer film (column 6, lines 10 – 27). The capping layer can be made of a clear PVDF film such as Avimark C40 and C70 (column 6, lines 23 – 27). Gleim teaches that the structural layer, or “substrate layer”, can be a PVF (polyvinyl fluoride) layer (column 8, lines 55 – 57).

As to claims 3 and 4, Gleim teaches that the ink or toner in the printed layer is deposited on the textured layer by a screen, electrostatic transfer, ink jet and gravure processes (column 6, lines 15 – 20), therefore, the textured layer will have at least one same color as found in the “ink layer”. Gleim teaches that the textured layer can also be colored and include pigmented particles (column 5, lines 42 – 45).

As to claims 6 – 7, Gleim teaches that the textured layer, or “embossable layer”, ranges in thickness from about 1 mil to about 5 mil (column 5, lines 35 – 38).

As to claims 8 – 9, Gleim teaches that the capping layer, or “protective layer”, has a thickness ranging from 0.4 mils to 1.0 mils (column 6, lines 23 – 25).

As to claim 10, Gleim teaches that the textured layer, or “embossable layer”, can include polyurethane (column 5, lines 29 – 30).

As to claim 12, Gleim teaches that the thermoplastic fluorinated polymer film is PVF (polyvinyl fluoride) or PVDF (polyvinylidene fluoride) (column 6, lines 10 – 27).

Art Unit: 1771

As to claims 1, 5, 11, 19, 21 and 23, Gleim fails to teach that the structural layer, or “substrate layer”, can be a prepreg comprising a woven material. Gleim fails to teach that the woven material is made from glass, aramid, carbon or Kevlar fibers.

Hirosaki is directed to a lightweight decorative panel used for the interior wall panels of airplanes (page 1, [0001]). Hirosaki teaches a laminate comprising a pigmented surface decorative layer attached to a woven prepreg (Abstract). Hirosaki teaches that the woven prepreg comprises glass, Kevlar or carbon fibers (page 4, [0016]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the woven prepreg of Hirosaki as the structural layer, or “substrate layer”, in the laminate of Gleim to create a durable and high in strength laminate with high temperature resistance.

#### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1 - 12, 19, 21 and 23 have been considered but are moot in view of the new ground(s) of rejection.

8. Applicant's arguments with respect to claims 17 – 18, 20, 22 and 24 filed May 6, 2003 have been fully considered but they are not persuasive.

9. In response to Applicant's arguments that Gleim does not disclose a pigmented embossable layer wherein the pigment of the embossable layer matches the coloration of the ink layer, the Examiner respectfully argues the contrary. Gleim does teach that the embossable layer is coated with ink or toner which would provide a particular coloring to the layer. By the use of pigmentation, the Applicant does not necessarily exclude coloration by coating. Pigments can be

Art Unit: 1771

added to a substrate superficially or added into the structure such as by coloring the resin before processing.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer A Boyd whose telephone number is 703-305-7082. The examiner can normally be reached on Monday thru Friday (8:30am - 6:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

*Jennifer Boyd*  
Jennifer Boyd  
July 9, 2003

*Mla Ruddock*